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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,994	09/04/2003	Toru Makino	X2007.0139	4585

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EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3682

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/653,994

Applicant(s)

MAKINO ET AL.

Examiner

Vinh T. Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong  
Primary Examiner

## Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/9/04

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Applicant's election of Group I in the reply filed on March 31, 2006 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claim 3 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 31, 2006.

Applicant stated in the Response to Restriction Requirement on March 31, 2006 that "Applicant hereby elects Group I (claims 1 and 2) and *cancel claim 2*, without prejudice, to expedite the allowance of this matter." It appears that Applicant intends to cancel claim 3 instead of claim 2 because claim 3 is drawn to nonelected invention. Since Applicant has not submitted an amendment to cancel claim 3, therefore, claim 3 is withdrawn pending Applicant's submission of the amendment to cancel claim 3.

3. Claims 1 and 2 are objected to because of the following informalities: (a) the claims contain grammatical or typographical error. For example, "A steering" in line 1 of claim 1 should have been changed to "A steering wheel"; and (b) no antecedent basis is seen for the terms, such as, "the ligneous thin plate" (singular, emphasis) and "the adhesive sheet" (singular, emphasis) in claim 1. Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "thin" in claim 1 is a relative term which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what dimension of the plate is required in order to be considered as "thin plate."

The Markush group in claim 2 is improper since it does not recite the closed term "consisting of." See MPEP 2173.05(h).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. Claim 1, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (i.e., Applicant's Figs. 7, 9, and 10) in view of Kawada (JP 9076449 cited by Applicant).

Regarding claim 1, Admitted Prior Art (APA) teaches a steering comprising a core 14 and a surface material 15 covering the core 14, the core 14 and the surface material 15 being integrally formed, wherein the surface material 15 comprises a surface decorative material 16, a plurality of ligneous thin plates (not shown. *Ibid.*, line 6 of paragraph [0007] of Applicant's specification), and adhesive sheets comprising an adhesive sheet 19 and un-illustrated adhesive sheets that are applied on the ligneous thin plates (*id.*, lines 1-4 of paragraph [0008] of Applicant's specification) for adhering between the surface decorative material 16 and the ligneous thin plate (not shown) and between the ligneous thin plates (not shown).

APA teaches the invention substantially as claimed. However, APA does not explicitly teach the adhesive sheet comprising a base material in which an adhesive resin having a moisture resistance is permeated.

Kawada teaches a well known adhesive sheet comprising a base material 12 in which an adhesive resin 13 having a moisture resistance is permeated in order to have an excellent sense of depth and texture. See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious).

It would have been obvious to one having ordinary skill in the art to use Kawada's adhesive sheet as the adhesive sheet in APA's steering wheel in order to adhere APA's surface

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decorative material to the ligneous thin plate, and to adhere the ligneous thin plates together in order to have an excellent sense of depth and texture as taught or suggested by Kawada.

9. Claims 1 and 2, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (i.e., Applicant's Figs. 7, 9, and 10) in view of Cavalli (US Patent No. 6,524,515 B1).

Regarding claim 1, Admitted Prior Art (APA) teaches a steering comprising a core 14 and a surface material 15 covering the core 14, the core 14 and the surface material 15 being integrally formed, wherein the surface material 15 comprises a surface decorative material 16, a plurality of ligneous thin plates (not shown. *Ibid.*, line 6 of paragraph [0007] of Applicant's specification), and adhesive sheets comprising an adhesive sheet 19 and un-illustrated adhesive sheets that are applied on the ligneous thin plates (*id.*, lines 1-4 of paragraph [0008] of Applicant's specification) for adhering between the surface decorative material 16 and the ligneous thin plate (not shown) and between the ligneous thin plates (not shown).

APA teaches the invention substantially as claimed. However, APA does not explicitly teach the adhesive sheet comprising a base material in which an adhesive resin having a moisture resistance is permeated.

Cavalli teaches a well known adhesive sheet comprising a base material (cloth) in which an adhesive resin having a moisture resistance is permeated in order to prevent deforming, warping or detaching. *Ibid.*, Abstract, Summary of the Invention, and claims 1-18. See also *In re Leshin, supra*.

It would have been obvious to one having ordinary skill in the art to use Kawada's adhesive sheet as the adhesive sheet in APA's steering wheel in order to adhere APA's surface

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decorative material to the ligneous thin plate, and to adhere the ligneous thin plates together in order to prevent deforming, warping or detaching of APA's multilayer steering wheel as taught or suggested by Cavalli.

Regarding claim 2, Cavalli's adhesive resin, that has a moisture resistance, is made of at least one thermosetting resin selected from epoxy resins and melamine resins. *Ibid.*, col. 4, lines 23-33.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Nakatsuji et al. (epoxy resin adhesive sheet), Testa (epoxy, polyurethane resin. See paragraph [0014]), Veiga (epoxy resin), Shimizu et al. (Figs. 1-6), Hosokawa et al.'192 (Figs. 1-11), Kawata et al. (adhesive sheets 21-23), and Shimizu et al.'748 (Figs. 1-3).


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

April 10, 2006



Vinh T. Luong  
Primary Examiner